

## REMARKS

Claims 1-28 are canceled.

Claims 29-44 are pending in the application.

Claims 30, 31, 33-36, 39-41, 43 and 44 are withdrawn from consideration.

Claims 37-38 and 42 are objected to because of informalities.

Claim 32 is rejected under 35 U.S.C. § 112.

Claims 29, 32, and 37 are rejected under 35 U.S.C. § 103(a).

Claim 38 is rejected under 35 U.S.C. § 103(a).

Claim 42 is rejected under 35 U.S.C. § 103(a).

Claims 29, 32, 37-38 and 42 are amended.

No new matter is added.

Applicant requests reconsideration and allowance of the claims in light of the above amendments and following remarks.

### *Claim Objections*

Claims 37-38 and 42 are objected to because these claims recite “according to any one of claim 29.” As suggested by the Examiner, claims 37-38 and 42 are amended to recite, “according to claim 29.” Applicant thanks the Examiner for indicating that such amendments do not affect the scope of the claims and will not be considered as an amendment necessitating new grounds of rejections.

### *Claim Rejections- 35 USC § 112*

Claim 32 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subjected matter which applicant regards as the invention. Applicant respectfully traverses the rejections.

Claim 32 has been amended to recite, “a third conductive pattern formed on another of the sheets to extend over the unit elements in a transverse direction of both the ends of another of the sheets” to clarify the patentable subject matter of the claimed invention, e.g., being consistent with the terms of claim 29, which claim 32 depends from. This limitation is supported in, for example, FIG. 7, in which a third conductive pattern 312 is formed on a third sheet 303. Applicant confirms that the terms, “another of the sheets” appearing twice in claim 32, refer to

the same sheet. Accordingly, Applicant believes that claim 32 as amended is now definite under 35 U.S.C. 112, second paragraph. Thus, the rejection of claim 32 under 35 U.S.C. 112, second paragraph, is now overcome.

***Claim Rejections- 35 USC § 103***

Claims 29, 32 and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over IDS reference US Patent No. 5,495,387 to Mandai (“Mandai”) in view of US Patent No. 4,746,895 to Kato (“Kato”). Applicant respectfully traverses the rejections.

Claim 38 is rejected 35 U.S.C. § 103(a) as being unpatentable over Mandai and Kato as applied to claim 29 above, and further in view of US Patent No. 5,917,403 to Hashimoto (“Hashimoto”).

Claim 42 is rejected 35 U.S.C. § 103(a) as being unpatentable over Mandai and Kato as applied to claim 29 above, and further in view of US Patent No. 5,430,429 to Nakamura (“Nakamura”). Applicant respectfully traverses the rejections.

Claim 29 is amended to recite,

“at least two sheets laminated on each other, each of the sheets having a desired property;  
a plurality of first internal electrodes formed on a first sheet and a second sheet, ...

a second internal electrode formed on at least another of the sheets to extend across the unit elements;

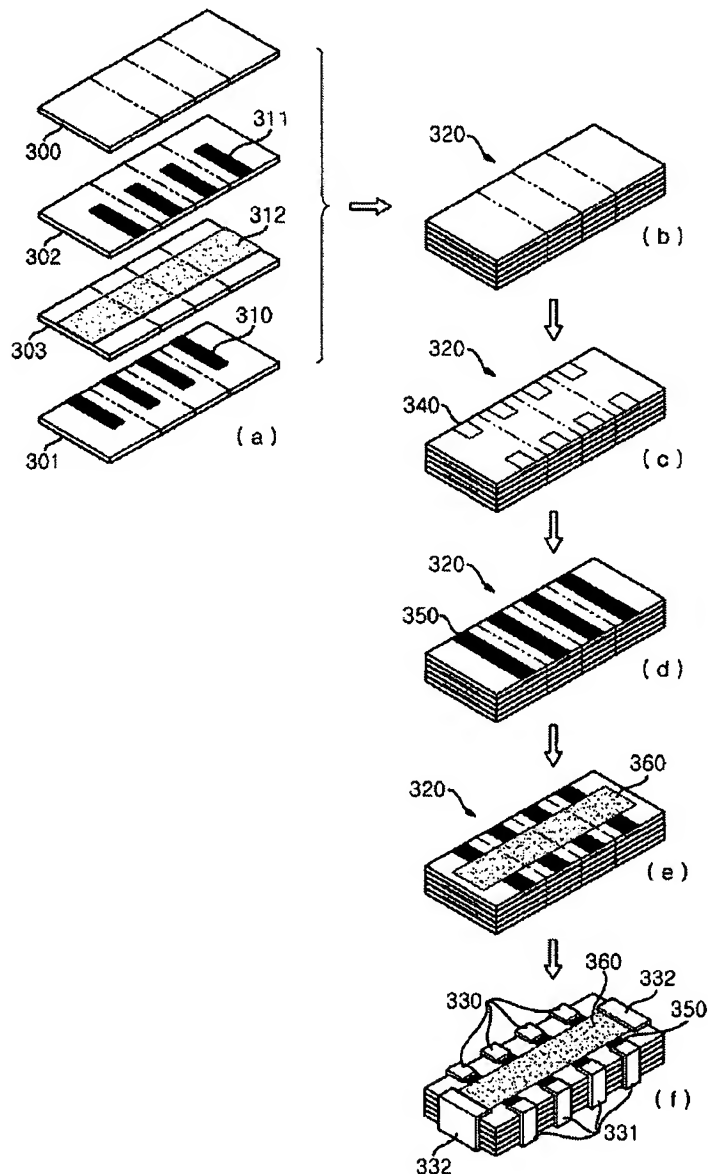
....

wherein the plurality of **first external terminals** are arranged on a **first side** of the unit elements, and wherein the plurality of **second external terminals** are arranged on a **second, opposite side** of the unit elements;

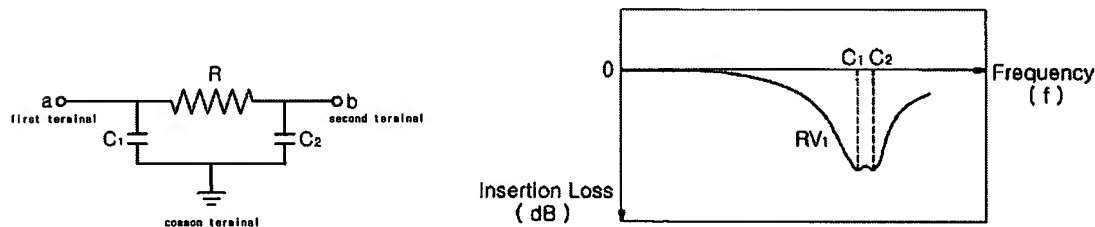
wherein said first internal electrode includes a plurality of first conductive patterns formed on the first sheet having a direction arranged from the first side of the unit element towards the second side of the unit element, each of the first conductive patterns being arranged in each of the unit elements, and a plurality of second conductive patterns formed on the second sheet in a direction arranged from the second side of the unit elements towards the first side, each of the second conductive patterns being arranged in a respective one of the unit elements; and

wherein ends of the first conductive patterns are connected to the first external terminals on the first side of the unit elements and ends of the second conductive patterns are connected to the second external terminals on the second side of the unit elements.”

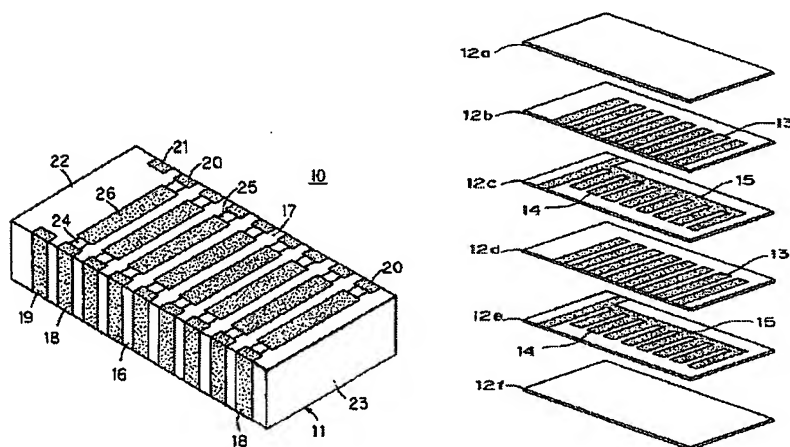
This amendment may be supported in FIG. 7 and the corresponding text of the present application. For example, ends of the first conductive patterns 310 on a first sheet 301 are connected to first external terminals 330 on the first side of the unit elements, and ends of the second conductive patterns 311 on a second sheet 302 are connected to second external terminals 331 on the second side of the unit elements, **opposite to the first side**. Accordingly, the first conductive patterns 310 are connected to the first external terminal 330 on a side opposite to where the second conductive patterns 311 are connected to the second external terminal 331.

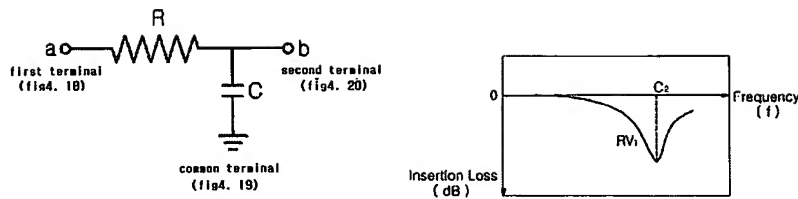


As a result, as illustrated in Fig. 4, the elements in claim 29 have two resonance frequencies caused by the two capacitance values. Thus, with the claimed invention recited in claim 29, high frequency noise can be reduced or eliminated in a wider frequency range.



In contrast, in Mandai, a first internal electrode is formed as a first conductive pattern 13 on a ceramic sheet 12b and a second conductive pattern 13 on a ceramic sheet 12d. The first conductive pattern 13 and the second conductive pattern 13 are, however, both exposed **to the same side** of the sheet to be connected to one external terminal 18, as illustrated in Fig. 3. Therefore, Mandai does not teach or suggest, among other things, “the plurality of **first external terminals** are arranged on a **first side** of the unit elements, and wherein the plurality of **second external terminals** are arranged on a **second, opposite side** of the unit elements,”... “**ends of the first conductive patterns are connected to the first external terminals on the first side of the unit elements and ends of the second conductive patterns are connected to the second external terminals on the second side of the unit elements,** as recited in claim 29. Elements shown in Mandai have only one capacitor C1 and one resonance frequency as illustrated below. Thus, Mandai merely discloses a simple RC array, not the  $\pi$  type RC circuit.





As the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original).

Therefore, the rejection does not present a *prima facie* case of obviousness as none of the cited references including Mandai, either alone or in combination, do not teach or suggest all of the features of claim 29 as discussed above. Accordingly, Applicant respectfully submits that claim 29 is in condition for allowance.

At least for the reasons set forth above, claim 29 is in condition for allowance, and the other dependent claims 32, 37-38 and 42 are also in condition for allowance by virtue of their dependency.

### ***Election of Species***

Applicant would like to thank the Examiner for indicating that claim 29 is a generic claim as in page 2 of the Office Action dated May 28, 2009. Upon allowance of generic claim 29, Applicant respectfully requests that the Examiner properly process all of the species claims including ones which have been withdrawn.

### **CONCLUSION**

For the foregoing reasons, reconsideration and allowance of all pending claims of the application as amended is requested. The Examiner is encouraged to telephone the undersigned at (503) 896-2643 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,



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